



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,205	01/14/2004	Ann C. Merenda	POU920000085US3	3572

7590 12/12/2006

IBM Corporation
Intellectual Property Law
2455 South Road, P386
Poughkeepsie, NY 12601

EXAMINER

PONIKIEWSKI, TOMASZ

ART UNIT	PAPER NUMBER
----------	--------------

2165

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/757,205	Applicant(s) MERENDA ET AL.	
	Examiner Tomasz Ponikiewski	Art Unit 2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Amendment filed on September 29, 2006 has been received and entered.

Claims 1-45 are pending.

2. The Applicant's communication overcomes some objections and rejections under 112 and 101.

Claim Objections

3. Claims 16, 31, 35, 36, and 45 are objected to because of the following informalities:

Claims 16, 31, 35, 36, and 45 recite the word "for" in the body of the claims. It indicates intended use and as such does not carry patentable weight. The word could be changed to recite "to". The limitations following the phrase "for" describes only intended use but not necessarily required functionality of the claim. Limitations following the phrase "for" do not carry patentable weight, which cause the claims to appear as a series of non-functional descriptive material/data without any functional relation with each other. Applicant is required to amend the claims so that the claim limitations are recited in a definite form. For example, claim 16 recites "creator for" should be "creator to" or "creator that".

Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 16 and 31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 16 and 31 do not list any hardware (i.e. computer) tied to the steps in order to operate the steps of the claims therefore resulting in software only implementation. Claim 31 needs a computer or processor for the code to perform its functionality. Computer code can't exist on its own, it needs to be run on a computer.

Claim 16 recites a "system" in the preamble. While the body of the claim lists modules, separator, creator, receiver, finder, which are software only, furthermore the specification does not list the system to include hardware; therefore the component of the "system" appear to be software only. Dependent claims carry the same deficiency.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2165

7. Claims 4-5, 19-20 and 34-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4-5, 19-20, and 34-35 recite "blind analysis". It is unclear what the applicant means by the term blind or what is meant by blind analysis in terms of the remaining claim recitation.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-5, 10-20, 25-35 and 40-45 are rejected under 35 U.S.C. 102(e) as being anticipated by de l'Etraz et al. (US 6,073,138).

As per claims 1, 16, 31 de l'Etraz et al. is directed to accessing data records in a private data set having restricted access, the records in the private data set being accessible only by authorized users (column 5, lines 61-62), the method comprising the steps of:

Art Unit: 2165

separating a data record into a public data record stored in a public data set and a private data record stored in a private data set (figure 1a, elements 102a and 104a)

creating a logical link logically relating the public data record with the private data record (column 10, lines 47-65, wherein both databases are relational databases which are organized into relational tables and as such are logically linked, by use of ownerID);

receiving a request from a user to perform a predefined operation, the request comprising information from the public data record, the user not authorized to access the private data set (column 5, lines 52-56);

finding the private data record using the information from the public data record received from the user in combination with the logical link (column 5, 55-63);

and performing the predefined operation using the private data record (column 5, lines 55-59).

As per claims 2, 17, 32 de l'Etraz et al. is directed to the logical link comprises a key value stored in the public data record and the private data record (column 11, lines 1-4).

As per claims 3, 18, 33 de l'Etraz et al. is directed to the information from the public data record received from the user comprises a key value stored in the private data record (column 11, lines 3-4, wherein key value is stored in a field denoted by "a").

Art Unit: 2165

As per claims 4, 19, 34 de l'Etraz et al. is directed to the predefined operation comprises blind analysis of data in a plurality of private data records (column 5, lines 55-63).

As per claim 5, 20, 35 de l'Etraz et al. is directed to the further step of forwarding the results of the blind analysis to the user (column 5, lines 55-63).

As per claim 10, 25, 40 de l'Etraz et al. is directed to the performing the predefined operation step is performed only when a required condition is satisfied (column 8, lines 44-67).

As per claim 11, 26, 41 de l'Etraz et al. is directed to the required condition is based upon information in the private record (column 8, lines 50-55).

As per claim 12, 27, 42 de l'Etraz et al. is directed to the private data record comprises data regarding any one of a link ID, a key, a consumer or an enterprise (column 11, lines 1-4).

As per claim 13, 28, 43 de l'Etraz et al. is directed to the public data record comprises data regarding any one of a link ID, a key, a consumer or a product (column 11, lines 1-4).

Art Unit: 2165

As per claims 14, 29, 44 de l'Etraz et al. is directed to the performing the predefined operation step comprises the further step of retrieving data from any one of the private data record or the public data record (column 17, lines 2-13).

As per claims 15, 30, 45 de l'Etraz et al. is directed to forwarding the retrieved data to the user (column 7, lines 28-31, wherein the data is in the form of web page).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 6-9, 21-24, and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over de l'Etraz et al. (US 6, 073,138) in view of Scroggie et al. (US 6,014,634).

As per claims 6, 21, 36 de l'Etraz et al. does not teach performing the predefined operation comprises the further steps of:

using information from the private data record as a network address;

Scroggie et al. teaches performing the predefined operation comprises the further steps of:

using information from the private data record as a network address (Scroggie et al., column 12, lines 50-53);

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine de l'Etraz et al. by teachings of Scroggie et al. to include using information from the private data record as a network address because it would allow contact or update between entities (Scroggie et al., column 4, lines 20-30).

de l'Etraz et al. as modified does not teach transmitting a message to the network address.

Scroggie et al. teaches and transmitting a message to the network address (Scroggie et al., column 12, lines 57-58).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine de l'Etraz et al. as modified by teachings of Scroggie et al. to include transmitting a message to the network address because it would make contact or update between entities easier and faster (Scroggie et al., column 4, lines 20-30).

As per claims 7, 22, 37 de l'Etraz et al. does not teach the message comprises email.

Scroggie et al. teaches the message comprises email (Scroggie et al., column 12, 57-58)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine de l'Etraz et al. by teachings of Scroggie et al. to

Art Unit: 2165

include the message comprises email because e-mail permits contact between entities in an easy and comfortable way (Scroggie et al., column 4, lines 20-30).

As per claims 8, 23, 38 de l'Etraz et al. does not teach the message comprises message information from any one of the private data record or the public data record.

Scroggie et al. teaches the message comprises message information from any one of the private data record or the public data record (Scroggie et al., column 12, lines 40-47).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine de l'Etraz et al. by teachings of Scroggie et al. to include the message comprises message information from any one of the private data record or the public data record because information in the records determine what the message will contain (Scroggie et al., column 2, lines 65-67; column 3, lines 1-9).

As per claim 9, 24, 39 de l'Etraz et al. does not teach the message comprises marketing material.

Scroggie et al. teaches the message comprises marketing material (Scroggie et al., column 12, 59-64).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine de l'Etraz et al. by teachings of Scroggie et al. to include the message comprises marketing material because it makes sense to use the

Art Unit: 2165

invention in a business environment (Scroggie et al., column 2, lines 65-67; column 3, lines 1-9).

Response to Arguments

12. Applicant's arguments filed 9/29/2006 have been fully considered but they are not persuasive.

Applicant's argument that de l'Etraz et al. does not teach "creating a logical link" is not deemed persuasive.

de l'Etraz et al. teaches that two databases are in use, private and public. de l'Etraz et al. also teaches use of public record is allowed based on ownerID which in light of applicants specification on page 11 paragraph 0027, could be interpreted as logical link.

Applicant's argument that Scroggie et al. does not teach "logical link" is not deemed persuasive. de l'Etraz et al. deals with the logical link, and combined with Scroggie et al. make persuasive case of obviousness.

In response to applicant's argument that the functional language following the word "for" is a positive limitation and indicates how a particular element operates in use is not deemed persuasive.

Art Unit: 2165

The language does not indicate how a particular element operates in use, it indicates the possibility of optionally using the element not the actual functionality. Changing the "for" to "to" or "that" would overcome this rejection.

The response to the non-final action does not address the issue of 112 2nd problem with "blind analysis" and its support in the disclosure. Therefore, the rejection is maintained.

In response to applicant's argument to 101 issues of software only implementation are not deemed persuasive.

Applicant's argument that specification indicates that present invention may be embodied in a system is not deemed persuasive. System does not have to be implemented with use of hardware component. The definition of system does not have to be a "computer" system. As such it is not meet the standard of being useful, concrete and tangible. The mention of a system is not enough to assume that the system is implemented with/on machine (i.e. computer) with hardware components.

Applicant's argument that the claim 31 is statutory is not deemed persuasive.

The claim does not meet the requirements of at least being tangible. The claim mentions comprising a computer readable medium does not include the tangibility of the claim. The computer code/program needs to be executed on a hardware component to

Art Unit: 2165

produce the useful result. Moreover the claim does not produce useful and concrete result.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tomasz Ponikiewski whose telephone number is (571)272-1721. The examiner can normally be reached on 8:00-4:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on (571)272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2165

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JEFFREY CARRIN
SUPERVISOR, PATENT EXAMINER
TECHNOLOGY CENTER 2100

Tomasz Ponikiewski
December 6, 2006